SUPREME COURT, U. S.
FILED
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MICHAEL RODAK, JR.,

No. 75-1092

In the Supreme Court of the United States

OCTOBER TERM, 1975.

PIHER INTERNATIONAL CORPORATION and PIHER SOCIEDAD ANONIMA,

Petitioners,

vs.

OTS CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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THE PETITION PRESENTS NO QUESTION OF SUFFICIENT IMPORTANCE TO WARRANT REVIEW BY THIS COURT

The petition offers no reason for granting the writ either under Rule 19 of this Court or in the exercise of this Court's extraordinary and discretionary jurisdiction. No special or important reasons for its grant are stated as required by Rule 19, no conflict exists between different courts concerning the validity of the single patent to which

the petition relates[1], and no conflict is even alleged to exist with respect to any question decided by the lower courts. While the petition refers briefly to *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) (PBr. 6), it does not assert that either court below failed to follow the standards therein enunciated for applying the obviousness test of 35 U.S.C. §103 and it does not assert that the decisions of the courts below conflict in any way with any parts of the *Graham* decision.

The petition also refers briefly to *Sakraida* v. *Ag Pro, Inc.*, (Docket No. 75-110 of this Court) and requests clarification of the instant case "*perhaps companion*" to *Sakraida* (PBr. 6). But the questions to be decided in *Sakraida*, as set forth in the petition for writ of certiorari in that case, are not involved in the present petition and the sole question posed for review by the petition here (PBr. 3) is not even remotely involved in *Sakraida*.[2] Thus,

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[1] U. S. Patent No. 3,518,604, hereinafter referred to as '604, a copy of which is included as Appendix D to the petition. The pages of the petition are referred to herein as PBr. ..... and the pages of the appendices are referred to as A ....., B ....., C ....., D ....., E ....., and F ....., respectively.

[2] In *Sakraida* the questions presented for review are whether the lower court decision conflicts "with applicable recent decisions of this Court", whether the patent claim there involved is "void because of over claim", whether the Appellate Court erred in setting aside findings of the trial court under Rule 52 F.R.C.P. and whether the Appellate Court erred in setting aside the trial court's finding that a new trial was warranted because of newly discovered evidence sufficient to rebut any presumption of validity. Not one of these issues is even asserted to exist in the present case. Of course, both cases involve the application of 35 U.S.C. §103 but, if that fact alone warranted granting of the petition, almost all recent patent cases would have to be reviewed.

there are no common issues warranting review of the present case either "companion to" *Sakraida* or independently.

This is a routine patent case involving only the private interests of the litigants. No question of widespread or general public interest is presented. The U. S. Patent and Trademark Office, after citing and carefully considering the principal prior art reference relied upon by Petitioners[3] and other prior art,[4] found the subject matter as a whole claimed in '604 would not have been obvious to a person of ordinary skill in the art. A Senior District Court Judge (C-1), highly experienced in patent matters, considered the prior art, including the two references referred to in the petition. The trial court specifically found the only prior art patent which had not been cited by the Examiner[5] was "less pertinent than the Patent Office references" (C-12) and, applying the criteria of *Graham* in the light of expert testimony and other relevant facts (C-7 and C-11 to C-12), determined that the differences between the "subject matter as a whole" claimed in '604 and the prior art would not have been obvious to a person of ordinary skill in the art (C-11 to C-12). A distinguished panel of the Seventh Circuit Court of Appeals[6] carefully reviewed the prior art, expressly recognized that the prior art cited by the Patent and Trademark Office Examiner

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[3] U. S. Patent No. 3,237,140 (hereinafter referred to as '140). (E-1 to E-7).

[4] Part of this art is listed at D-5.

[5] Patent No. 3,375,478, hereinafter referred to as '478, F-1 to F-7.

[6] The panel comprised former Justice Clark, Senior District Judge Grant and the author of the opinion (A-1).

"was more pertinent than '478'"[7] and then applied the standards of *Graham*, whereupon all three judges agreed that the subject matter of '604 was "patentable" (A-6). The petition merely seeks another review of these three unanimous decisions by the tribunals below.

THE QUESTION PRESENTED

Because the case is devoid of any real issue warranting review, the petition poses a question (PBr. 3) which was never considered by either court below, is based upon no findings of fact of the trial court and was neither briefed nor argued before either the district court or the court of appeals.[8] The rhetorical question posed is merely an attempt to seize upon a single, hypothetical statement of

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[7] Petitioners' reference to the failure of Respondent to direct the Examiner's attention to '478 (PBr. 5) overlooks the conclusion of the court of appeals that, since the reference was less pertinent than the prior art previously cited by the Examiner, Respondent made a "permissible exercise of judgment" that citation of '478 would serve no useful purpose (A-6 and A-7). The court merely followed well established law that a patent applicant is not required to set up a straw man which he earnestly and in good faith believes can be readily knocked down, *United States* v. *Standard Electric Time Company*, 155 F.Supp. 949, 952 (D. Mass. 1957), a frequently cited case.

[8] The *only* issue presented by Petitioners for review by the court of appeals that related to the validity of '604 was as follows:

> "Did the District Court err in concluding that the claimed subject matter of the '604 patent would not have been obvious to a person having ordinary skill in the art (35 U.S.C. §103)?"

While this broadly framed issue could be interpreted to encompass the question here posed for review (PBr. 3) and many others, Petitioners' arguments in the court of appeals, as will be shown, did not include that question.

the Court of Appeals[9] and magnify that statement into an alleged issue of sufficient importance to warrant review by this Court. Assuming, *arguendo,* that the question (PBr. 3) is truly that important, even though no case law or other facts have been presented to show that it is, its resolution by this Court should await an appropriate case in which the issue is squarely presented and in which the facts and law have been adequately developed in and found by the lower court. This Court should not decide any important question in the context of a single, hypothetical statement, the significance and true meaning of which is not entirely clear. Thus, if any issue is presented by the petition, it is simply whether this Court should grant a petition for writ of certiorari for the sole purpose of reviewing a non-obviousness determination unanimously made by three tribunals below.

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[9] The court, in passing, said (A-5): *"If* the flared bearing in *'604* merely performed the function of maintaining a secure relationship among the components during adjustment, Piher's argument would be valid." (Emphasis added) Thus, the court indicated that *if* the '604 invention had been something other than the court actually found it was, a different result might have been reached. The court of appeals, however, considered the subject matter as a whole of the invention, as 35 U.S.C. §103 and this Court's decision in *Graham* require, and found that subject matter "patentable" (A-6). The exact nature of the hypothetical structure which *might have been* found unpatentable by the appellate court is not clear. There is nothing in the decision of that court or that of the trial court indicating that either court found it would have been obvious to combine the prior art to produce the invention actually taught by and claimed in '604, as the question presented for review presumes to be the case.

STATEMENT OF THE CASE

Petitioners' statement of the case, insofar as it relates to '604 (PBr. 5), misinterprets the decision of the court of appeals, disregards the findings actually made by the trial court and is incomplete, inaccurate and highly argumentative. Respondent, therefore, presents its own statement of the case.

The '604 invention, as the trial court found, "achieved an efficient, relatively inexpensive variable resistor control" (C-10). The control includes a housing with a closure member forming a wall and having an aperture in one wall accommodating a barrel portion of the driver (C-10). Prior art controls of the enclosed type, including that disclosed in Petitioners' principal reference (the '140 patent), invariably required a separate resilient seal or washer 42[10] compressed between the housing 11 and the driver 40 to exclude dust. The '604 invention eliminated the need for such seals to effect the dust exclusion and thus eliminated a part previously believed essential while retaining the sealing function theretofore performed by that part. This desirable result was accomplished by making the driver of relatively soft, heat-deformable material so that a barrel portion thereon could be deformed or flared outwardly to form a seal against dust or other contaminants (C-12) as contrasted with '140 wherein the driver is non-deformable (i.e., it is made of steel—E-3 and E-5).

Petitioners' statement of the case (PBr. 5) inaccurately suggests that mere substitution of a part (i.e., the enlarged portion 31c) from '478 for a bearing aperture in '140 would produce the subject matter claimed in '604. Actually, the proposed substitution would require discarding the steel driver portion of '140 and the washer 42 and

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[10] See Figs. 1-3 of '140 (E-1).

reconstruction of the former to eliminate the dust excluding seal 42.

The '478 patent discloses an open potentiometer construction having no closed housing and no seal. The bearing for the driver in '478 is formed by expanding the shaft 31 until it seats within an aperture 14b (F-4, column 4, lines 35 to 43) and not by rolling over or deforming a barrel portion of the driver as claimed in '604. The enlarged portion 31c in '478 is formed during the heat swaging operation employed to expand the shaft. The expansion of the shaft to form the bearing in '478 permits adjustment of the torque on the driver by manually pushing the shaft into or out of the aperture (F-5, column 5), a result that is undesirable in '604 where a seal is desired and the parts are not moved manually to adjust torque.

Instead of arguing the question here presented for review (PBr. 3), Petitioners urged in the courts below that '478 discloses use of a flared bearing to provide a dust excluding seal.[11] The court of appeals disposed of this argument by pointing out that '478 "does not concern itself with the use of any sealing member" and "neither implicitly nor explicitly suggests that the enlarged portion of the shaft may be used to perform a sealing function" (A-5). Apparently, Petitioners would like to reargue this fact issue because their question (PBr. 3) argumentatively asserts that the seal is merely "*allegedly* not disclosed" in the prior art and because they assert (PBr. 5) the feature "*allegedly* is not adequately disclosed". But this Court does not review such factual determinations.

As was stated above, the court of appeals made no statement, either expressly or by implication, that the combina-

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[11] Petitioners' argument to the court of appeals (page 52 of its appellate brief) was as follows:

"The sealing feature is also provided by the flared bearing of the '478 patent (PX-2, Column 4, Lines 34-43)."

tion of references proposed by Petitioners "is obvious" as the petition asserts (PBr. 5). To the contrary, the court of appeals recognized that, because '478 "had no relevance to the function of sealing an opening in a housing" (A-6), it does not fairly suggest the combination of diverse teachings from the prior art as proposed by Petitioners. Moreover, the court did not state that the subject matter claimed in '604 was rendered nonobvious *solely* because it involves an "additional purpose" as Petitioners argue (PBr. 5). Thus, the "anomaly in the law" alleged in the petition (PBr. 5) is simply not raised by the lower court decisions.

CONCLUSION

Petitioners' only stated reason for review is to clarify the *Graham* decision (PBr. 6) under the guise of a question not decided by either court below. Any necessary clarification or elucidation of *Graham* will undoubtedly be forthcoming in the *Sakraida* case.

Petitioners, in essence, seek a further review of the unanimous determination of non-obviousness by all of the tribunals below. But this Court has consistently declined to provide another forum for such review, *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 58 S.Ct. 849 (1938) and *Magnum Import Co.* v. *Coty*, 262 U. S. 159, 43 S.Ct. 531 (1923). The petition for writ of certiorari should be denied.

Respectfully submitted,

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